REMARKS

Claims 1-4, 6-17, 20-42, 44, 46-48, and 51 are pending in the application. Claims 1-4, 6-17, 20-42, 44, 46-48, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,721,784 B1 to Leonard et al ("Leonard") in view of US Patent No. 6,272,484 B1 to Martin et al. ("Martin").

Reconsideration is requested. The rejections are traversed. No new matter is added. Claims 1 and 26 are amended. Claim 8 is canceled. Claim 52 is added. Claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51-52 remain in the case for consideration.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-4, 6-17, 20-42, 44, 46-48, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,721,784 B1 to Leonard, et al ("Leonard") in view of US Patent No. 6,272,484 B1 to Martin, et al. ("Martin"). The applicant traverses the rejections.

The Examiner remains steadfast in asserting that "Leonard teaches the invention substantially as claimed," at least with respect to claim 1. *See* Office Action, page 5. At page 3 of the Office Action, the Examiner suggests that the argument pertaining to a single file containing both the information and the viewer is no persuasive because the "origination software 2" and the "viewer applet 4" of Leonard are "integrated into a single program or applet," that no difference exists between that and the "viewer applet [being] contained with the message itself in a single file." *See* Office Action, page 3. However, neither the origination software 2 nor the viewer applet 4 is a message: they are both tools that support operations on a message. Leonard does not teach that the viewer applet is contained with the message itself in a single file.

For example, the function of the origination software tool is to prepare and deliver a message to a server "via a standard electronic mail connection." *See* Leonard, column 17, lines 18-20. And the viewer applet is a tool for viewing messages ("If a viewer has not already been installed, then the additional steps of installing the viewer applet on the recipient's computer . . . must be performed.") *See* Leonard, column 18, lines 23-27. Even if the origination software tool is combined with the viewer applet tool into a "single program or applet," the result is just that – a combination of two software tools into one program or applet. This fails to anticipate the

inclusion of text and at least one image with a viewer in a single rich media file, as set forth in claim 1.

The Examiner appears to implicitly concede that Leonard fails to teach each of the limitations of claim 1 because of a reliance and combination with Martin in a 35 U.S.C. § 103(a) rejection. With respect to the argument that combining Leonard with Martin would render Leonard unsatisfactory for its intended purpose, the Examiner suggests that a motivation to combine is provided by Leonard for the purpose of "'allowing control of viewing and handling of the electronic field message and allowing the user to view the message using the applet viewer.'" *See* Office Action, page 6, citing Leonard, column 14, lines 58-62. The Examiner also suggests that Martin provides a motivation to combine in that "'this method should enable a first user to provide a second user with a web page image as originally viewed by the first user.'" *See* Office Action, page 6, citing Martin, column 2, lines 58-62.

However, MPEP 2143.01(V) states "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." As described above, it is a "basic concept" of the Leonard invention that a message and a viewer applet exist separately. The message is encrypted and can only be decrypted by the viewer applet. This ensures that the originator has control over deletion of the message. *See* Leonard, column 14, line 61 through column 15, line 6. Combining the self-executable image file of Martin with the message of Leonard would render Leonard's invention unsatisfactory for its intended purpose. If the message of Leonard included the viewer code as taught be Martin, there would be no need for the (separate) viewer applet. But if the viewer code is included with the message, then anyone who receives the message automatically receives the viewer code, and is therefore able to view the message. The encryption of Leonard, used to prevent persons without the proper viewer from viewing the message, is rendered pointless.

Since the combination of Leonard and Martin would render Leonard unsatisfactory for its intended purpose, there is no motivation to combine the references as suggested by the Examiner. Since this combination forms the basis of all rejections in this Office Action, the Examiner has failed to make a prima facie argument that the claims are unpatentable under 35 U.S.C. § 103(a) over Leonard in view of Martin, and the claims should therefore be allowable.

It is also suggested that Leonard teaches checking means for checking if there is a later version of the rich media file. *See* Office Action, page 5, citing Leonard column 13, lines 32-55 and column 12, lines 51-67. Although Leonard teaches at column 13, lines 51-55 that control of the messages (lifespan, handling, and wrapper) can be "directed to versions of the message received by recipients in a particular subspace," Leonard fails to teach checking if there is a later version of a message. Indeed, the term "later version" does not ever appear in Leonard. Martin also fails to teach the checking means as set forth in claim 1.

Despite the lack of *prima facie* obviousness as discussed above, the applicant presents amendments to the claims in the interest of moving this case toward allowance.

Claim 1 has been amended to include the limitations of claim 8. Claim 8 has therefore been canceled. Claim 1 now sets forth a rich media file stored in a machine-readable medium, comprising: information to be displayed on a computer system, the information including text and at least one image, wherein the information is compressed using a compression technique to reduce the size of the rich media file; a viewer designed to display the information on the computer system including a decompression engine to decompress the compressed rich media file, the information and the viewer contained in a single file; and checking means for checking if there is a later version of the rich media file.

The Examiner points to Martin, column 6, lines 55-67 and column 7, lines 1-33 as teaching a compression technique. Martin teaches standard image compressions techniques such as JPEG, GIF, TIFF, "or other known graphics formats." *See* Martin, column 7, lines 7-10. In other words, Martin teaches compressing graphic formats alone. But claim 1 sets forth the ability to compress a rich media file, which includes at least text and images, as supported by page 10, lines 10-18. Thus, the compression technique of Martin fails to teach each of the limitations of amended claim 1.

With respect to the argument that structuring the rich media file so that deleting the rich media file would remove both the information and viewer, the Examiner indicates that "it is obvious that removing or deleting a single file in order for the file to leave no footprint in the system is not a novelty and that a person having ordinary skill in the art understands that removing the single program or file of Martin or Leonard or any other file would accomplish the same result." *See* Office Action, page 4. The applicant respectfully suggests that the Examiner

misunderstood the applicant's explanation of leaving no footprint on the computer system. To clarify, the applicant has amended claim 26 to set forth a method for building a unitary rich media file, the method comprising: assembling information for the unitary rich media file; formatting the information coupling the information with a viewer; and converting the information and the viewer to the unitary rich media file, so that if the unitary rich media file is removed, neither the information nor the viewer remains on a user's system.

Leonard does not teach that its email message/viewer applet leaves no footprint on a user's system when removed. Further, deleting the email message of Leonard still leaves the viewer applet on the user's system, which is exactly one of the drawbacks of the conventional methods that the present application was designed to avoid. *See* Specification, page 1, line 30 to page 2, line 2. And Leonard says nothing about being able to remove both an email message and a viewer applet by deleting a single file (such as the unitary rich media file being built in claim 26). Martin does not correct these defects in Leonard, as Martin says nothing about deleting files and leaving no footprint. Amended claim 26 clarifies that if the unitary rich media file is deleted, this act does not remove just the information associated with the rich media file, but also the viewer. Leonard and Martin fail to teach this limitation, whether individually or in combination with one another.

New claim 52 sets forth new limitations pertaining to a rich media file stored in a machine-readable medium, comprising: a client identifier to identify a creator of the rich media file; a unique identifier to identify the rich media file; a version number identifying a version of the rich media file; a print module to enable printing of the rich media file if included by the creator of the rich media file and to disable printing if excluded by the creator; a first dialogue box structured to appear responsive to viewing limits of the rich media file, the first dialogue box to communicate to a user an invitation to access another rich media file; a second dialogue box structured to appear responsive to an update offer, the second dialogue box for prompting the user of the rich media file to check for a newer version of the rich media file; a requester structured to retrieve the newer version of the rich media file responsive to an action by the user according to the update offer; information to be displayed on a computer system, the information including text, at least one still image, and structured to include at least one of an animated image, a link to a web page, and an email link; and a viewer built-in to the rich media file to display the information on the computer system, wherein the client identifier, the unique
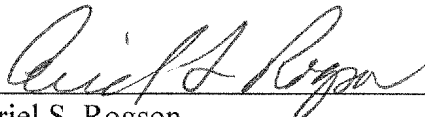
identifier, the version number, the print module, the viewing limits, the update offer, the requester, the information to be displayed, and the built-in viewer comprise a single file. The applicant submits that the prior art fails to teach each of the limitations of claim 52. Thus, claim 52 is allowable over the prior art.

With respect to independent claims 13, 14, 42, and 46, the applicant relies on substantially the same arguments as set forth above, and incorporates by reference the remarks set forth in the previous responses. Furthermore, the applicant notes that claims 2-4, 6-7, and 9-12 depend from claim 1, claims 15-17 and 20-25 depend from claim 14, claims 27-41 depend from claim 26, claim 44 depends from claim 42, claims 47-48 depend from claim 46, and claim 51 depends from claim 13. Based at least on these dependencies, and on their own merits, the claims are allowable over the prior art.

For the foregoing reasons, reconsideration and allowance of claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51-52 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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